



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,664	10/09/2001	Mark D. Ackerman	112024-0078	6325
21186	7590	09/23/2004	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			BADI, BEHRANG	
		ART UNIT	PAPER NUMBER	
		3621		

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

R

Office Action Summary	Application No.	Applicant(s)	
	09/973,664	ACKERMAN ET AL. <i>MW</i>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 October 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 October 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/09/2001.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. Claims 1-23 have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6, 10, 15, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Haruki, U.S Patent Application Publication US2001/0013099 A1.

3. As per claim 1, Haruki discloses a system for licensing external processes on a computer comprising (Abstract):

- an electronic license that identifies one or more software commands for registration (Abstract, lines 1-9);
- an interface that registers the identified software commands (page 5, claim 3);
- and a command processor that executes the identified and registered software commands (figure 11).

4. As per claim 6, Haruki further discloses the electronic license including one or more fields identifying one or more hardware serial number, the hardware

serial numbers corresponding to one or more computers on which the license is valid (page2, [0034]).

5. As per claim 10, Haruki discloses a license upgrade, the license upgrade containing one or more fields identifying additional hardware resources licensed for use (page 3, [0053]).

6. As per claim 15, Haruki discloses a method for licensing external processes on a server comprising the steps of (Abstract):

- Generating an electronic license that includes a plurality of software command directives for accepting or rejecting registration, by one or more external processes, of software commands (Abstract, lines 1-9); and
- registering software commands based upon the software command directives (page 5 claim3); and
- executing the registered commands (figure 11).

7. As per claim 22, Haruki discloses a computer-readable medium including program instructions executing on a computer for licensing external processes on a server, the program instructions performing the steps of (abstract):

- generating an electronic license that identifies one or more software commands for registration (abstract, lines 1-9);
- registering, with an interface, the identified software commands (page 5, claim 3]; and
- executing, with a command processor, the identified and registered software commands (figure 11).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 3, 4, 5, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haruki, U.S Patent Application Publication US2001/0013099 A1, as applied to claim 1 above, and further in view of Misra et al., U.S. Patent 6,189,146.

10. As per claim 2, Haruki discloses a system for licensing external processes on a computer (Abstract), as described above. Haruki does not disclose a computer comprising a proxy cache server. Misra et al. discloses a computer comprising a proxy cache server (col. 2, lines 62-67; and figure 1, item 32). It would have been obvious to modify Haruki to include a computer comprising a proxy cache server such as that taught by Misra et al. in order to have data more easily available.

11. As per claim 3, Haruki discloses a system for licensing external processes on a computer (Abstract), as described above. Haruki does not disclose a proxy cache server being a part of a proxy cache server cluster that comprises a plurality of proxy cache servers interconnected over a network. Misra et al. discloses the proxy server being a part of a proxy cache server cluster that comprises a plurality of proxy cache servers interconnected over a network (col.4, lines 43-48). It would have been obvious to modify Haruki to include a

proxy cache server that was part of a plurality of proxy cache servers interconnected over a network such as that taught by Misra et al. in order to have data more easily available.

12. As per claim 4, Haruki discloses a system for licensing external processes on a computer (Abstract), as described above. Haruki does not disclose an electronic license comprising one or more fields identifying a server version, the server version defining server models on which that electronic license is valid. Misra et al. discloses an electronic license further comprising one or more fields identifying a server version, the server version defining server models on which that the electronic license is valid (abstract, lines 1-13). It would have been obvious to modify Haruki to include an electronic license further comprises one or more fields identifying a server version, the server version defining server models on which that the electronic license is valid such as that taught by Misra et al. in order to validate the license.

13. As per claim 5, Haruki discloses a system for licensing external processes on a computer (Abstract), as described above. Haruki does not disclose an electronic license which includes one or more fields identifying a license expiration date, the license expiration date defining a period of time that the electronic license will allow access. Misra et al. discloses a field in the electronic license identifying a license expiration date, the license expiration date defining a period of time that the electronic license will allow access (col. 7, table 1). It would have been obvious to modify Haruki to include a field in the electronic license identifying a license expiration date, the license expiration date defining a

period of time that the electronic license will allow access such as that taught by Misra et al. in order for the client to know when it's time to renew the license agreement.

14. As per claim 9, Haruki discloses a system for licensing external processes on a computer (Abstract), as described above. Haruki does not disclose an electronic license comprises a license upgrade, the license upgrade including a software commands-to-register field identifying another set of software commands that the interface may register in addition to the software commands identified by one or more prior licenses. Misra et al. discloses an electronic license comprises a license upgrade, the license upgrade including a software commands-to-register field identifying another set of software commands that the interface may register in addition to the software commands identified by one or more prior licenses (col. 18, lines 17-38). It would have been obvious to modify Haruki to include an electronic license comprising a license upgrade, the license upgrade including a software commands-to-register field identifying another set of software commands that the interface may register in addition to the software commands identified by one or more prior licenses such as that taught by Misra et al. in order for the client to upgrade their license agreement.

15. As per claim 11, Haruki discloses a system for licensing external processes on a computer (Abstract), as described above. Haruki does not disclose an electronic license being a license upgrade, the license upgrade containing one or more fields identifying hardware resources that add further capabilities to hardware resources previously licensed for use by one or more

prior licenses. Misra et al. discloses an electronic license being a license upgrade, the license upgrade containing one or more fields identifying hardware resources that add further capabilities to hardware resources previously licensed for use by one or more prior licenses (col. 18, lines 17-38; col.12, lines 56-67). It would have been obvious to modify Haruki to include an electronic license being a license upgrade, the license upgrade containing one or more fields identifying hardware resources that add further capabilities to hardware resources previously licensed for use by one or more prior licenses such as that taught by Misra et al. in order for the client to upgrade their license agreement.

16. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haruki as applied to claim 1 above, and further in view of Garst et al. U.S. Patent 6,188,995.

17. As per claim 7, Haruki discloses a system for licensing external processes on a computer (Abstract), as described above. Haruki does not disclose a command, which includes means for restricting usage of predetermined hardware resources on the computer based upon the electronic license. Garst et al. discloses a command, which includes means for restricting usage of predetermined hardware resources on the computer based upon the electronic license (col. 1, lines 21-35). It would have been obvious to modify Haruki to include a command, which includes means for restricting usage of predetermined hardware resources on the computer based upon the electronic license as that taught by Garst et al. in order to limit the usage of the client based on the license agreement.

18. As per claim 8, Haruki discloses a system for licensing external processes on a computer (Abstract), as described above. Haruki does not disclose an electronic license, which includes one or more fields identifying a set of hardware resources licensed for use, wherein only the set of hardware resources licensed for use will be used by the command processor in executing the identified and registered software commands. Garst et al. discloses an electronic license, which includes one or more fields identifying a set of hardware resources licensed for use, wherein only the set of hardware resources licensed for use will be used by the command processor in executing the identified and registered software commands (col. 1, lines 21-35). It would have been obvious to modify Haruki to include an electronic license, which includes one or more fields identifying a set of hardware resources licensed for use, wherein only the set of hardware resources licensed for use will be used by the command processor in executing the identified and registered software commands such as that taught by Garst et al. in order to limit the clients abilities bases on the license agreement.

19. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haruki as applied to claim1 above, and further in view of Muyres et al., U.S Patent Application Publication US2001/0010046 A1.

20. As per claim 12, Haruki discloses a system for licensing external processes on a computer (Abstract), as described above. Haruki does not disclose an electronic license coded in Extensible Markup Language (XML) defining a set of codified command directives that provide information that

enables the interface to, either, accept or reject registration of the identified software commands. Muyres et al. discloses an electronic license coded in Extensible Markup Language (XML) defining a set of codified command directives that provide information that enables the interface to, either, accept or reject registration of the identified software commands (page 23, [0326]). It would have been obvious to modify Haruki to include an electronic license coded in Extensible Markup Language (XML) defining a set of codified command directives that provide information that enables the interface to, either, accept or reject registration of the identified software commands such as that taught by Muyres et al. in order to better manage the license agreement.

21. Claim 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haruki as applied to claim 1 above, and further in view of Carter et al. U.S. patent 6,219,652.

22. As per claim 13, Haruki discloses a system for licensing external processes on a computer (Abstract), as described above. Haruki does not disclose an electronic license which includes a software commands-to-register field including means for identifying inclusion of a root software command, the root software command identifying all software commands that share the root software command for registration and the interface being adapted to register all software commands that share the root software command. Carter et al. discloses an electronic license which includes a software commands-to-register field including means for identifying inclusion of a root software command, the root software command identifying all software commands that share the root

software command for registration and the interface being adapted to register all software commands that share the root software command (col. 7, lines 55-67).

It would have been obvious to modify Haruki to include an electronic license which includes a software commands-to-register field including means for identifying inclusion of a root software command, the root software command identifying all software commands that share the root software command for registration and the interface being adapted to register all software commands that share the root software command such as that taught by Carter et al. in order to better handle the software commands handling the license agreement.

23. As per claim 14, Haruki discloses a system for licensing external processes on a computer (Abstract), as described above. Haruki does not disclose a software commands-to-register field which further includes means for identifying exclusion of a predetermined software command from the software commands that share the root software command so as to cause the interface to reject registration of the predetermined software command that is excluded.

Carter et al. discloses a software commands-to-register field which further includes means for identifying exclusion of a predetermined software command from the software commands that share the root software command so as to cause the interface to reject registration of the predetermined software command that is excluded (col. 7, line 67 – col. 8, line 1). It would have been obvious to modify Haruki to include a software commands-to-register field which further includes means for identifying exclusion of a predetermined software command from the software commands that share the root software command so as to

cause the interface to reject registration of the predetermined software command that is excluded such as that taught by Carter et al. in order to better manage the license agreement.

24. Claim 16, 17, 18, 19, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haruki as applied to claim 15 above, and further in view of Misra et al. U.S. Patent 6,189,146.

25. As per claim 16, Haruki discloses a method for licensing external processes on a server (Abstract), as described above. Haruki does not disclose directing the one or more external processes to only use a set of licensed hardware resources, the set of licensed hardware resources being defined by one or more fields in the electronic license. Misra et al. discloses directing the one or more external processes to only use a set of licensed hardware resources, the set of licensed hardware resources being defined by one or more fields in the electronic license (col. 7, table 1). It would have been obvious to modify Haruki to include directing the one or more external processes to only use a set of licensed hardware resources, the set of licensed hardware resources being defined by one or more fields in the electronic license such as that taught by Misra et al. in order to better handle the management of the different part of the license agreement.

26. As per claim 17, Haruki discloses a method for licensing external processes on a server (Abstract), as described above. Haruki does not disclose the step of generating which includes generating a license upgrade, the license upgrade defining a set of additional commands for registration that are not part of

software commands registered in conjunction with one or more prior licenses.

Misra et al. discloses the step of generating which includes generating a license upgrade, the license upgrade defining a set of additional commands for registration that are not part of software commands registered in conjunction with one or more prior licenses (col. 18, lines 17-38). It would have been obvious to modify Haruki to include the step of generating which includes generating a license upgrade, the license upgrade defining a set of additional commands for registration that are not part of software commands registered in conjunction with one or more prior licenses such as that taught by Misra et al. in order to better handle the license upgrades.

27. As per claim 18, Haruki discloses a method for licensing external processes on a server (Abstract), as described above. Haruki does not disclose the step of generating which, includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the one or more external processes that are not part of hardware resources licensed for use by prior licenses. Misra et al. discloses the step of generating which, includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the one or more external processes that are not part of hardware resources licensed for use by prior licenses (col. 18, lines 17-38). It would have been obvious to modify Haruki to include the step of generating which, includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the one or more external processes that are not part of hardware resources licensed for use by

prior licenses such as that taught by Misra et al. in order to better handle the license upgrades.

28. As per claim 19, Haruki discloses a method for licensing external processes on a server (Abstract), as described above. Haruki does not disclose the step of generating which includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the one or more external processes that add further capabilities to hardware resources licensed for use by prior licenses. Misra et al. discloses the step of generating which includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the one or more external processes that add further capabilities to hardware resources licensed for use by prior licenses (col. 18, lines 17-38; col. 12, lines 56-67). It would have been obvious to modify Haruki to include the step of generating which includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the one or more external processes that add further capabilities to hardware resources licensed for use by prior licenses such as that taught by Misra et al. in order to better handle the license upgrades.

29. As per claim 20, Haruki discloses a method for licensing external processes on a server (Abstract), as described above. Haruki does not disclose either one of (a) installing the electronic license in the server prior to shipment of the server to an end-user of the server and (b) providing the electronic license to the end-user on a removable media for installation in the server after the shipment of the server to the end-user. Misra et al. discloses either one of (a)

installing the electronic license in the server prior to shipment of the server to an end-user of the server and (b) providing the electronic license to the end-user on a removable media for installation in the server after the shipment of the server to the end-user (col. 2, lines 22-47). It would have been obvious to modify Haruki to include either one of (a) installing the electronic license in the server prior to shipment of the server to an end-user of the server and (b) providing the electronic license to the end-user on a removable media for installation in the server after the shipment of the server to the end-user such as that taught by Misra et al. in order to have more choices as to the installment of the electronic license.

30. As per claim 21, Haruki discloses a method for licensing external processes on a server (Abstract), as described above. Haruki does not disclose installing the electronic license in the server in an over-the-wire process including (a) digitally signing the electronic license by a vendor, (b) transmitting the digitally signed electronic license over a communications network from the vendor to the server, (c) validating the digitally signed electronic license by the server and (d) installing the validated electronic license in the server. Misra et al. discloses installing the electronic license in the server in an over-the-wire process including (a) digitally signing the electronic license by a vendor, (b) transmitting the digitally signed electronic license over a communications network from the vendor to the server, (c) validating the digitally signed electronic license by the server and (d) installing the validated electronic license in the server (col. 2, lines 22-47 and abstract). It would have been obvious to modify Haruki to include a installing the

electronic license in the server in an over-the-wire process including (a) digitally signing the electronic license by a vendor, (b) transmitting the digitally signed electronic license over a communications network from the vendor to the server, (c) validating the digitally signed electronic license by the server and (d) installing the validated electronic license in the server such as that taught by Misra et al. in order to have a more efficient way of installing the electronic license.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Haruki (U.S Patent Application Publication US2001/0013099 A1) discloses a software license management method, electronic device, and recording medium .

Misra et al. (U.S. Patent 6,189,146) teaches a software licensing system which includes a license generator located at a licensing clearinghouse and at least one license server and multiple clients located at a company or entity.

Garst et al. (U.S. Patent 6,188,995) teaches a method and apparatus for enforcing software licenses.

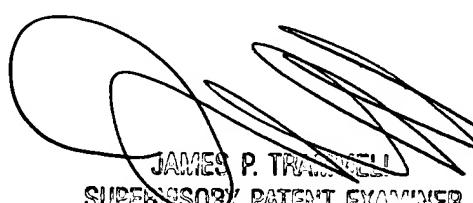
Muyres et al. (U.S. Patent Application Publication US2001/0010046 A!) discloses a client content management and distribution system.

Carter et al. (U.S. Patent 6,219,652) teaches a network license authentication system.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Behrang Badii whose telephone number is 703-305-0530. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

Behrang Badii
Patent Examiner
Art Unit 3621
September 8, 2004

BB